

**Amendments to the Drawings**

Please replace FIG. 1 with the Replacement Sheet that immediately follows the signature page of this Reply.

## Remarks

In the Office Action mailed December 27, 2005:

1. The drawings were objected to;
2. Claims 4-7 were rejected under 35 U.S.C. § 112 ¶ 2; and
3. Claims 1-5 and 7 were rejected under 35 U.S.C. § 102(3) as being anticipated by Reece (U.S. Patent No. 6,783,926).

### I Restriction

Applicant renews the traversal of the Examiner's restriction requirement and requests a replacement first office action be issued addressing all claims, or at least claims 1-7 and 17-33.

#### (A) Group I claims (1-26) vs. Group II claims (27-33)

In sub-paragraph "(a)" in paragraph 1 of the office action (page 2), the Examiner's distinction between the detachable keys of claims 17 and 27 is specious – both keys include a signal conductor or conduit. One skilled in the art would find little, if any, distinctive difference between "within said portion [of the electronic assembly], a signal conduit configured to carry a signal" (claim 17) and "said [detachable] key [of the electronic assembly] comprising a signal conductor configured to convey a signal" (claim 27).

Also, Applicant reasserts that independent claim 27 describes a process that cannot be practiced by an apparatus materially different from apparatus described in claims 1-26.

#### (B) Claim 17 is a Generic Claim

Contrary to the Examiner's assertion, the limitation of "wherein one or more functions of the electronic assembly become inoperable when said portion is detached from the assembly" of claim 17 does read on Figure 1. At a minimum, trace 106 of figure 1 would become inoperable if key 104 was detached from assembly 102.

#### (C) Omission of claim 6 from Specie I

Applicant asserts that if claim 1 is elected subject matter, then claims depending from claim 1 are also elected subject matter. The Examiner states that claim 6 does not read on Figure 1, yet it depends from claim 1 which the Examiner states does read on Figure 1. In particular,

claim 4 (which depends from claim 1) recites an additional element – “identification means” – and was found to be elected subject matter. Claims 5 and 6 depend from claim 4 and recite examples of the “identification means”. If claim 5 comprises elected subject matter, then claim 6 does also.

(D) Claim 25 should be included in Specie I

If the Examiner omits a dependent claim (claim 6) of an independent claim (claim 1) that is elected subject matter, then suitable dependent claims of independent claims that are allegedly not elected matter should be included in Specie I. For example, claim 25 (depending from claim 17) reads on figure 1.

II      “Identification”

Based on the rejections and statements in the office action, it appears the Examiner may not understand the word “identification,” which is used in several claims (e.g., claims 4-7, 8-16, 18-23 and 29-32). Merriam Webster’s Collegiate Dictionary (10<sup>th</sup> edition) defines “identification” as, *inter alia*, “evidence of identity.” Thus, “identification means”, “identification”, “identification module”, “identification code” and/or other elements recited in the claims may be interpreted as providing evidence of identity.

This is compatible with the text of the specification: “the key may include some form of identification” (page 2, lines 10-11), “some form of identification may be included on a key” (page 4, lines 12-13), “an identification number or code is permanently encoded or programmed” (page 5, lines 17-18) and so on.

The Examiner’s statements make it clear that Applicant’s use of “identification” was not understood. For example, the Examiner states (page 3, paragraph 2 of the office action) that the “identification circuit” recited in claim 4 is not shown in the figures. (Note that the Examiner cited claim 4, but it is claim 5 that includes the words “identification circuit”). However, FIG. 2 includes “ID chip 210”, which clearly constitutes an identification circuit, as described at page 5, lines 17-24:

Key 204 includes ID chip 210, on which an identification number or code is permanently encoded or programmed. Chip 210 may comprise a preprogrammed identification module (e.g., a PROM or EPROM) offered by Dallas Semiconductor, Maxim Integrated Products or some

other manufacturer. ID chip 210 may be encapsulated to prevent its removal and installation on a different assembly. Illustratively, the identification code may be unique and complex (e.g., long), and may be laser encoded, to prevent it from being easily cloned.

As another example, and as discussed below in Section V, the Examiner asserts that a contact pad in Reece (U.S. Patent No. 6,783,926) constitutes an “identification means” capable of identifying an assembly that includes the contact pad. Nothing in Reece indicates that a contact pad could serve as a means for identification.

### III Drawings

(A) Objection under 37 CFR 1.83(a) regarding “identification circuit” (paragraph 2 of the office action)

As described above in Section II, FIG. 2 depicts ID chip 210, on which an identification number or code is encoded or programmed. Clearly, then, ID chip 210 provides an identification and reads on “an identification circuit”.

However, Applicant has amended FIG. 1 to include optional identification 110. As described in the specification (e.g., page 4, lines 3-24), several different types of identification are contemplated.

(B) Objection under 37 CFR 1.83(a) regarding structural detail essential for a proper understanding of the disclosed invention (paragraph 3 of the office action)

Applicant asserts that one of ordinary skill would readily understand the meaning of “barcode,” “hologram,” “etched identification string,” etc. Further, FIG. 2 already depicts ID chip 210, which may be interpreted as an “electronic identification chip” and clearly qualifies as “some form of identification” as described on page 4, line 12. Because this portion of the specification describes “another embodiment of the invention,” and the Examiner has interpreted FIGs. 1-4 as pertaining to four separate embodiments or species (however correctly or incorrectly that interpretation may be), “some form of identification” need not be illustrated in each figure.

### IV Rejections under 35 U.S.C. § 112 ¶ 2

As described above in Section II, the Examiner appears to have misinterpreted the word “identification.” In particular, the Examiner appears to have defined “identification means” in a

manner contrary to the specification and the claims. The specification and claims are believed to be clear in describing that, in an embodiment of the invention, a mechanism for facilitating proof that an electronic assembly (e.g., a circuit board) has been disabled may include some form of identification means for identifying the mechanism or assembly.

(A) The Examiner equated the “identification means” of claim 4 with the trace and gaps of claims 2 and 3 (page 5, 2<sup>nd</sup> paragraph of paragraph 5 of the office action). Because claim 4 does not depend from either claim 2 or claim 3, there is no conflict between “identification means” and “trace” and “gaps”.

(B) The Examiner asked “what does applicant mean of ‘identification means for’ ”. The language “identification means for” is believed to be clear. “[I]dentification means” may be interpreted as “means for identifying” or “means for providing evidence of identity” as described in Section II. The Examiner identified portions of the present application that provide examples of identification means (e.g., page 4, lines 3-24) and therefore appears to understand this term.

(C) The Examiner asked “What does it cause to be identifying the mechanism (trace +gaps)?” Applicant is unsure what the Examiner is asking, as claim 4 clearly states “identification means for identifying the mechanism” (emphasis added). Thus, in the embodiment of claim 4, the identification means identify the mechanism for provably disabling the circuit board.

(D) Finally, the Examiner states “By applying art, the examiner assumes that the “identification means” is a circuit.” This statement demonstrates clear error. The Examiner cannot resort to prior art to define a term in a patent being examined, especially since the specification and claims clearly define “identification means”. See *Philips v. AWH Corporation*, 2005 WL 1620331 (Fed. Cir. 2005) (*en banc*). The Examiner himself identified several examples of “identification means” in the specification and therefore had no need to refer to prior art.

Applicant strenuously objects to the Examiner’s use of prior art to interpret “identification means” and the resulting erroneous interpretation. The phrase is clear in its use in the claims, and numerous illustrative examples are provided in the specification.

V      Reece (U.S. Patent No. 6,783,926)

A.      **Reece Does Not Include Identification Means**

Claimed embodiments of the present invention recite some form of identification for identifying a mechanism or key of a circuit board or assembly, so that the disabling of the circuit board or assembly can be proved.

The Examiner equated Applicant's "identification means" with the "contact pad 32 on the IC card 30" of Reece (column 10, line 48). This comparison is invalid and must fail.

(1)      As recited in claims 1 and 4, for example, Applicant's "identification means" is part of a mechanism for provably disabling a circuit board, and the mechanism also includes "signal means" and "separation means". In particular, Applicant's "identification means" identifies and is part of the mechanism comprising Applicant's signal means, and is part of Applicant's circuit board.

The Examiner identified Reece's circuit board 22b as being equivalent to Applicant's "circuit board." Reece's circuit board 22b includes wire trace 26a, which the Examiner equated with Applicant's "signal means."

However, contact pad 32 is not part of Reece's circuit board. Instead, Reece's contact pad is part of an IC card that is *wholly separate from the circuit board* and can be used with any circuit board. Therefore, Reece's contact pad cannot be compared to Applicant's "identification means".

(2)      Also, the Examiner's interpretation of "identification means" as a contact pad conflicts with the plain language meaning of "identification means" as well as Applicant's use of "identification" within the claims and the specification. In particular, a single contact pad as used in Reece is utterly incapable of identifying any assembly or circuit board that comprises the contact pad.

VI      Selected Claims

A.      **Claims 1-7**

Claim 1 has been amended to include the subject matter of claim 4. As described above in section V, Reece does not include "identification means for identifying the mechanism."

Further, as described above in Section II, the Examiner's interpretation of Applicant's "identification" is impermissibly based on the prior art and conflicts with Applicant's use of the term.

Also, claim 6 is not and has not been withdrawn, yet the Examiner omitted it from the examined claims.

#### B. Claims 8-16

Claims 8-16 are directed to elected subject matter and should be examined. In particular, the Examiner required FIG. 1 be amended to include "identification." **Claims 8-16 therefore read on FIG. 1 even more closely than they did originally, and are now elected subject matter.**

Claim 8 was amended to make it clearer that, in this embodiment of the invention, the identification is capable of identifying the electronic assembly. As described above in Section V, Reece does not teach or suggest any form of identification for identifying an electronic assembly, wherein that identification is part of a detachable key or mechanism.

#### C. Claims 17-26

As described above, claim 17 is believed to be generic to Species I-IV, and is believed to constitute elected subject matter and should be examined. At the very least, claim 25 reads on FIG. 1.

Claims 18-23 recite the inclusion of an identification module on the mechanism. As described above in Section V, Reece does not teach or suggest anything equivalent to the identification module. Because the Examiner required the inclusion of an "identification" in FIG. 1, claims 18-23 now read even more closely on FIG. 1 and **should now be treated as elected subject matter.**

#### D. Claims 27-33

As described above, the method of claim 27 should be examined with the apparatus of Group I claims.

As described in Section V, Reece does not teach or suggest any form of identification for identifying an electronic assembly, wherein that identification is part of a detachable key or

mechanism. Therefore, Reece cannot be interpreted as teaching or suggesting the “proffering” of claim 27.

Because the Examiner required the inclusion of an “identification” in FIG. 1, dependent claims 29-32 now read even more closely on FIG. 1 and **should now be treated as elected subject matter.**

### CONCLUSION

No new matter has been added with the preceding amendments. It is submitted that the application is in suitable condition for allowance. Such action is respectfully requested. If prosecution of this application may be facilitated through a telephone interview, the Examiner is invited to contact Applicant’s attorney identified below.

Respectfully submitted,

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